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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/403,803	03/17/95	ISRAELI	R 41426-A-PCT-

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18M1/0205

EXAMINER
CAPLITA, A

ART UNIT	PAPER NUMBER
1817	

DATE MAILED: 02/05/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/403,803

Applicant(s)

Israeli et al.

Examiner

Anthony C. Caputa

Group Art Unit

1817



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 12, 13, 22, 23, 34, 35, 45, 47, 50-52, and 74-79 ⁴⁹ is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1, 12, 13, 22, 23, 34, 35, 45, 47, 50-52, and 74-79 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1, 12, 13, 74-76 drawn to a nucleic acid encoding a prostate specific antigen.
- II. Claim 23 drawn to a ligand that binds to said antigen.
- III. Claim 22, drawn to a method of using the ligand to determine if said ligand binds to the antigen.
- IV. Claims 34 and 35, drawn to a antibody, directed to said antigen or a peptide of said antigen.
- V. Claim 45, drawn to a method of detection using said antibody and composition comprising said antibody and carrier (or radioisotope), classified in class 435, subclass 7.1.
- VI. Claim 47 drawn to a transgenic mammal which comprises the nucleic acid molecule encoding said antigen.

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VII. Claim 49-52, and 77 drawn to a method of treatment using the nucleic acid encoding said antigen.

VIII. Claims 78 and 79 drawn to a method of detection using primers that hybridize to said antigen.

2. The inventions are distinct, each from the other because of the following reasons:

A 371 case is considered to have unity of invention only when there is a technical relationship among those inventions involving one or more of the same or corresponding technical features. The expression "special technical feature" means those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. While the instant claims all involve the prostate specific antigen, it is clear from the PCT International Preliminary Examination Report, in particular Feng et al., that this feature does not define a contribution over the prior art.

The inventions listed as Groups I-VIII do not relate to a single inventive concept because they lack the same or corresponding technical features, since as stated above, the one special technical feature shared by all claims does not constitute a contribution over the prior art.

3. A telephone call was made to J. White to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Anthony C. Caputa whose telephone number is (703) 308-3995.

Anthony C. Caputa, Ph.D.

January 31, 1997